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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,864	05/19/2000	Toshio Inadate	450100-02508	1674
20999	7590	10/06/2005	EXAMINER	
FROMMERM LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			TRAN, TONGOC	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/575,864	INADATE, TOSHIO	
	<b>Examiner</b> Tongoc Tran	<b>Art Unit</b> 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 June 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/2/2005 has been entered. Claims 2-6 and 8-12 have been cancelled. Claims 1 and 7 are pending for examination.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1 and 7 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent No. 5,794,207) in view of Walker et al. (U.S. Patent No. 862,223) and further in view of Knee et al. U.S. Patent No. 5,589,892).

In respect to claim 1, Walker ['207] discloses an information processing apparatus connected to a plurality of information terminals by way of a network, comprising:

storing means for storing user information; wherein said user information includes a user ID, a password and an electronic mail address; authenticating means for authenticating a user based on said user information stored in said storing means (e.g. col. 8, lines 64-col. 9, line 5, storing means – buyer database , authentication means – authenticates the buyer's identification, user information – name, electronic mail address etc, col. 13, lines 2-3) ;

recording means for recording a request information transmitted by a first user authenticated by said authenticating means; wherein said first user is a customer and said request information is a request for an offer to sell goods matching the request to said customer (e.g. col. Col. 8, line 42-col. 9, line 16, recording means - buyer create conditional purchase offer, a description of the goods he wishes to obtain);

supplying means for supplying a service list of said request information recorded by said recording means to a second user authenticated by said authenticating means in response to a demand entered from said second user (e.g. col. 9, lines 10-16, supplying means for supplying a service list – a seller could log onto a website... see a listing of CPO subject categories);

said recording means recording service information transmitted by said second user in response to the request information in said service list; wherein said second user is a shop and said service information is said offer (e.g. col. 9, lines 17-30 and lines 45-50, recording means recording service information transmitted by the second

user – If, after viewing...the seller communicates his intent, col. 9, lines 17-18; seller...issuing a binding counteroffer ...col. 9, lines 45-47, counteroffer database, seller response database, col. 12, lines 59-60, col. 13, lines 10-39); Walker ['207] discloses tracking seller's response database (service information) with seller's information (Walker ['207], col. 13, lines 35-39) but does not explicitly discloses said seller's information is address information on the network for obtaining directly from said second user a desired information among said service information. However, Official Notice providing buyer address on the network about the seller is old and well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide seller' address on the network to the buyer with Walker ['207]'s seller responding to buyer's offer for the benefit of enabling buyer to make his/her decision of choosing the seller based information the seller offer rather than the server making the decision for the buyer.

Walker [207] does not explicitly discloses but Walker ['223] discloses searching means for searching for service information corresponding to said request information and said user information of said second user recorded by said recording means, in response to a demand for a request list from said first user; transferring means for transferring said request list to said first user, wherein said transferring means transfers said service information corresponding to said request information as a search result to said first user (e.g. Walker [223], col. 7, lines 30-35, line 67-col. 8, line 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the searching means of Walker's ['223] to enable the buyer to search for the

service information rather than having the buyer notified by the server taught by Walker ['207] for the benefit of providing the buyer, if he or she chooses, to visit the website to check for the response of the offer.

Walker ['207] does not explicitly disclose wherein said request list includes a mark which expresses the existence of service information. However, Knee discloses user receives listings with an asterick or "star" icon indicating that a product or service associated with each of the listing is available and may be ordered remotely by the user (Knee, col. 36, lines 67-col. 37, line 9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Walker's teaching of transferring service listings to user with Knee's teaching of providing a mark as an indicator of service available.

Furthermore, Walker ['207] does not explicitly disclose using electronic mail to transmit service information to the buyer. However, Official Notice is taken that using an electronic mail to transmit information to user is old and well known. It would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the electronic mail notification to buyer rather than having buyer keep login into the website to check on seller's offer.

In respect to claim 7, the claimed limitation is a method claim that is substantially similar to apparatus claim 1. Therefore, claim 7 is rejected based on the similar rationale.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (571) 272-3843. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Examiner: Tongoc Tran  
Art Unit: 2134

September 19, 2005



GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
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